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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,678	12/17/2003	Tetsuro Motoyama	245972US2 DIV	4128
22850	7590	11/08/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LUU, LE HIEN	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,678

Applicant(s)

MOTOYAMA, TETSURO

Examiner

Le H. Luu

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/17/03 - 07/26/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/17/03-05/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-27 are presented for examination.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kraslavsky et al. (Kraslavsky) patent no. 5,537,626, in view of Aziz patent no. 5,416,842. In addition, Banno et al. patent no. 4,867,606, Kaneko patent no. 4,720,813, Petteruti et al. patent no. 5,267,800, and Farrand et al. patent no. 5,559,958 are being used to support Kraslavsky's inherent teachings.

4. As to claim 1, Kraslavsky teaches the invention substantially as claimed, including a method of monitoring an office machine communicatively coupled to a network, comprising:

transmitting status information of the office machine over the Internet network
(col. 7 lines 38-63);

receiving the status information at a monitoring device, wherein the status information passes through the Internet network prior to being received by the monitoring device (col. 6 line 45 – col. 7 line 19); and

storing the status information in a database associated with the monitoring device, wherein the status information is stored in association with an identifier that uniquely identifies the office machine (col. 6 line 45 – col. 7 line 19; col. 38 lines 9-67).

However, Kraslavsky does not explicitly teach a firewall.

Aziz teaches coupling the Internet to a private network through a firewall associated with a node to act as a gatekeeper for messages transmit to and from the Internet (col. 4 line 65 – col. 5 line 16).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Aziz to pass status information through a firewall associated with the monitoring device prior to being received by the monitoring device because it would filter messages transmit between the Internet and the private network.

5. As to claim 2-4, Kraslavsky inherently teaches the office machine is a printer, a digital copier, or a facsimile machine (col. 1 lines 25-36; col. 2 lines 5-61; Kraslavsky's inherent teachings can be found in Background of the invention in Banno et al. patent no. 4,876,606).

6. As to claim 5, Kraslavsky teaches transmitting status information of the office machine as an electronic mail message over the Internet (col. 6 line 45 – col. 7 line 19; Decision from Appeal No. 1999-2767 of Application No. 08/738,461).

Art Unit: 2141

7. As to claims 6-8, Kraslavsky inherently teaches storing a serial number, model information, or attachment information of the office machine in the database in association with the status information (col. 6 lines 45-61; col. 38 lines 9-67; Kraslavsky's inherent teachings can be found in patent nos. 4,720,813, 5,267,800, and 5,559,958).

8. As to claim 9, Kraslavsky teaches storing a collection date in association with the status information, wherein the collection date indicates a date that the status information was received at the monitoring device (col. 6 line 45 – col. 7 line 19).

9. Claims 10-27 have similar limitations as claims 1-9; therefore, they are rejected under the same rationale.

10. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6,889,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the U.S. patent.

11. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010

(Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

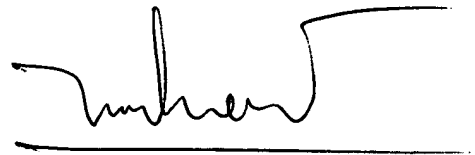
12. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

13. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu whose telephone number is 571-272-3884. The examiner can normally be reached on 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Le Hien Luu', is written above a horizontal line.

LE HIEN LUU
PRIMARY EXAMINER